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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,088	05/01/2001	Y. Tom Tang	PF-0622 USN	8378

7590 04/21/2003
Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

HUTSON, RICHARD G

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,088

Applicant(s)

TANG ET AL.

Examiner

Richard G Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) 21-23, 27-30 and 32-36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-26, 31 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 15.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicants preliminary amendment canceling claims 1-20 and adding new claims 21-36, Paper No. 13, 1/30/2003, is acknowledged. Claims 21-36 are at issue and are present for examination.

Election/Restrictions

Applicant's election with traverse of Group II, Claims 23-26, 28, 30 and 31 in Paper No. 13 is acknowledged. Applicant's further election with traverse of SEQ ID NO: 9I, Claims 24-26, 28 and 31 in Paper No. 13 is acknowledged. Applicants traverse the restriction requirement on several grounds.

First, applicants traverse the restriction requirement between Groups II and VII (III?) on the basis that the claimed methods are dependent on knowing the sequence of the polynucleotide of claim 31 and therefore a search of these two groups would substantially overlap and would thus not be an undue burden on the examiner. This argument is not found persuasive because knowing the sequence of the polynucleotide of claim 31 is not necessary to practice the invention of Group III (a method of detecting a polynucleotide) and the searches of these groups while overlapping are not coextensive and thus would cause an undue burden on the examiner.

Second, applicants traverse the restriction requirement between elected Group II drawn to polynucleotides and Group I drawn to polypeptides on the basis that many of the claimed polynucleotides encode the claimed polypeptides and thus a search for the

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polynucleotides would include the polypeptides which they encode. Applicants argument is not found persuasive because while the searches for the each of the groups overlap, they are not coextensive. For example, search of Group I would require search of subclass 530/350, a search of which would be unnecessary for the search of the elected group II. The reference applicants present in support of their reasons to maintain the different Groups together is not found persuasive because the searches necessary for a complete determination of novelty and un-obviousness requires more than a search of such a reference.

Third, applicants traverse the restriction requirement between Groups I and IV and hence Group II on the basis that these Groups could be examined at the same time also without undue burden on the examiner, as a search of the prior art for each of the groups would substantially overlap. As above this argument is not found persuasive because while the searches for the each of the groups overlap, they are not coextensive. For example, search of Group IV would require search of subclass 530/387.1, a search of which would be unnecessary for the search of the elected group II.

Applicants traverse the restriction requirement between elected Group II drawn to polynucleotides and newly added claim 27 drawn to a transgenic organism, as above, on the basis that a search of the different Groups would substantially overlap. It is noted that the invention of this newly added claim was not included in the original claim set, however as discussed above with respect to groups I and III, while the search of elected Group II and claim 28 would overlap, they are not coextensive. For example,

search of the subject matter of claim 28 would require search of subclass 800/13, a search of which would be unnecessary for the search of the elected group II.

Applicants further traverse the restriction requirement between elected polynucleotide of SEQ ID NO: 9 and those of SEQ ID NOs: 1-3, 5, and 6-8 on the basis that these claims are written as part of a Markush group. This argument is not found persuasive on the basis that the newly added claims are not drawn to a group that are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without a serious burden (i.e. 7 independent and distinct polynucleotide and polypeptide sequences). Further applicants have not disclosed what common utility each of the members of the group share nor have applicants disclosed the substantial structural feature disclosed as being essential to that utility.

Applicants comments with respect to the rejoinder of claims 32-34 are also acknowledged, however as discussed above, the methods of claims 32-34 are not subject to rejoinder as they do not recite methods of using the allowable product but instead methods of using fragments of the allowable product.

The requirement is still deemed proper and is therefore made FINAL.

Claims 21-23, 27-30, 32-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 13.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."

Applicants filing of information disclosures, Paper No. 14, filed 2/6/2003, is acknowledged. Those references considered have been initialed.

Allowable Subject Matter

Claims 24-26 and 31 are allowable over the prior art.

This application is in condition for allowance except for the following formal matters:

This application is in condition for allowance except for the presence of claims 21-23, 27-30, 32-36 to an invention non-elected with traverse in Paper No. 13.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach or suggest a polynucleotide encoding the acyl-CoA synthetase enzyme of SEQ ID NO: 4.

Interview Summary Enclosed

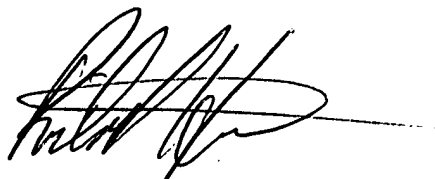
As noted in the enclosed interview summary, the examiner called applicant's representative to discuss the correction of formal matters to put the instant application in condition for allowance, specifically the cancellation of claims drawn to non-elected subject matter. Applicants indicated that they thought that newly added claims 32-34 drawn to methods of detecting a target polynucleotide having the sequence of a polynucleotide of claim 31 were subject to rejoinder. The examiner informed applicant's representative that claims 32-34 were not subject to rejoinder as they were not drawn to either a method of use or a method of making the polynucleotide of Group II. The examiner indicated to applicant's representative that the referred to claims, 32-36, were drawn to methods of use of a genus of polynucleotides that were considerably broader than the elected group. The applicant's representative disagreed with the examiner's interpretation and asked that an action be sent out so that applicant's representative would have more time to consider the issue.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G Hutson whose telephone number is (703) 308-0066. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read 'Richard Hutson', with a long horizontal flourish extending to the right.

Richard Hutson, Ph.D.
Primary Patent Examiner
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April 21, 2003